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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,399	07/27/2001	Sumita B. Mitra	56527US002	7742

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EXAMINER	
YOON, TAE H	

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 11/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/916,399	MITRA, SUMITA B.	
	Examiner	Art Unit	
	Tae H Yoon	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-40 is/are pending in the application.

4a) Of the above claim(s) 20-40 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-19 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Election/Restrictions

Claims 20-40 have been grouped together rather than group II(claims 20-34) and group III (claims 35-40).

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-19, drawn to a glass ionomer cement, classified in class 523, subclass 113+.

II. Claims 20-40, drawn to a method of curing and a method for treating tooth teeth, classified in class 433, subclass 226+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in treating (or fixing) broken ceramic articles and the process for using the product as claimed can be practiced with another materially different product taught by various prior art. Also, the cured product of Group II has a different structure from that of Group I.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Skolnick on October 23, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claim1-19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 20-40 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mitra et al (US 5,922,786).

Mitra et al teach a multiple-part glass ionomer cement comprising an acidic polymer having a plurality of polymerizable vinyl group (formula I at page 2 and Table 1 reciting an acidic copolymer of US Pat. 5,130,347 which contains said plurality of polymerizable vinyl group inherently), silane treated fluoroalumina silicate (col. 12, lines 5-36) and redox cure system (col. 9, lines 15-54). Mitra et al also teach various packaging utilizing water and curing agents at col. 8, line 23 to col. 9, line 14 wherein the use of one or more suitable polymerization initiators is also taught).

The instant invention further recites a polymer having a plurality of acidic repeating units but being substantially free of polymerizable vinyl group. However, Mitra et al teach employing a hydrophilic polymer to enhance adhesion in high moisture area at col. 7, lines 21-23 and 66 to col. 8, line 1. Mitra et al teach employing a polymer having at least one acidic group such as polymer and copolymers containing polyacrylic acid at col. 9, lines 58-59 and a polycarboxylic acid at col. 10, line 31 which are substantially free of polymerizable vinyl group.

Thus, the instant invention lacks novelty.

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitra et al (US 5,922,786) in view of Mitra (US 5,130,347).

Mitra et al teach an acidic copolymer in Table 1 referring to example 11 of US Pat. 5,130,347, and said patent shows a copolymer of acrylic acid and itaconic acid with IEM which comprising a plurality of acidic repeating units and a plurality of polymerizable vinyl group.

It would have been obvious to one skilled in the art at the time of invention to utilize the instantly recited components in Mitra et al since Mitra et al teach such modification absent showing otherwise and Mitra et al teach an acidic copolymer in Table 1 referring to example 11 of US Pat. 5,130,347 which meets the instant polymer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Tae H Yoon
Primary Examiner
Art Unit 1714

THY/November 3, 2003